



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Alexander Walland *et al.*

Examiner: Patricia L. Morris

Serial No.: 09/836,462

Group Art Unit: 1625

Filed: April 18, 2001

Docket: 1/1152/1088

For: BETAMIMETICS HAVING A LONG-LASTING ACTIVITY, PROCESSES FOR
PREPARING THEM, AND THEIR USE AS MEDICAMENTS

Assistant Commissioner for Patents
Washington DC 20231

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REPLY TO RESTRICTION REQUIREMENT

TECH CENTER 1600/2900

Sir:

This Reply is filed in answer to the Office Action dated January 4, 2002. In that Office Action, a one month shortened statutory period was set for response and this Reply is therefore timely. If it is determined, however, that any fees under 37 C.F.R. §§ 1.16 or 1.17 are due in connection with this Reply, authorization is hereby given to charge such fees to Deposit Account No. 02-2955. Furthermore, applicants also request that any subsequently filed reply requiring a petition for an extension of time for its timely submission be treated as if it incorporated such petition for an extension of time pursuant to the provisions of 37 C.F.R. § 1.136(a)(3) and hereby authorizes that any fees due in connection therewith be charged to Deposit Account No. 02-2955.

In the Office Action dated January 4, 2002, the Examiner imposed a restriction requirement in the instant application. The Examiner alleged that the claims of the instant application include three independent and distinct inventions as follows:

- Group I: claims 1 to 11 and 13, drawn to compounds and compositions;
- Group II: claim 12, drawn to multiple uses; and
- Group III: claims 14 and 15, drawn to compositions containing any unknown active ingredient.

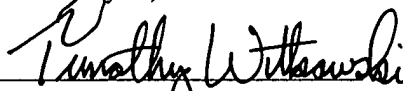
In response to that restriction requirement, applicants hereby elect with traverse to prosecute in this application the subject matter of Group I, claims 1 to 11 and 13. Applicants also elect the species of Example 2, 1-[2H-5-hydroxy-3-oxo-4H-1,4-benzoxazin-8-yl]-2-[3-(4-n-butyloxyphenyl)-2-methyl-2-propylamino]ethanol as the species for examination purposes. Applicants reserve the right to prosecute in one or more divisional applications whatever subject matter is not examined or allowed here. Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement for the reasons given below.

Group I and Group II are related as compounds and compositions and methods for using such compounds and compositions. Therefore, Groups I and II are sufficiently related such that the search for relevant art for one Group would be expected to uncover prior art that is relevant to the other Group, since Group I and Group II involve the same compounds and compositions. Thus, a search for relevant art and subsequent examination would not be an undue burden on the Examiner and the restriction should be withdrawn. M.P.E.P. § 803. It is therefore respectfully requested that the Examiner withdraw the restriction of Groups I and II.

Furthermore, Group I and Group III are related as Group III comprises compositions in Group I further comprising an additional active ingredient. Therefore, Group I and Group III are sufficiently related such that the search for relevant art for Group I would be expected to uncover all prior art that is relevant to Group III. Indeed, if Group I is patentable over the prior art, Group III should be as well, since Group III is necessarily within Group I. Thus, a search for relevant art and subsequent examination would not be an undue burden on the Examiner and the restriction should be withdrawn. M.P.E.P. § 803. It is therefore respectfully requested that the Examiner withdraw the restriction of Groups I and III.

Applicants respectfully submit that all the pending claims are allowable and therefore solicit a Notice of Allowance for all of the pending claims. If the Examiner feels that a telephone interview would be helpful in advancing prosecution of this application, the Examiner is invited to contact the attorney below.

Certificate of Mailing Under 37 C.F.R. § 1.8(a)
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on January 23, 2002.

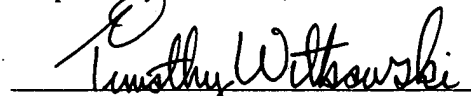


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1-23-2002

Dated

Respectfully submitted,



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